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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/876,276	06/16/1997	JAY SHORT	09010/020001	4852

28213 7590 06/30/2003

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SAN DIEGO, CA 92121-2133

EXAMINER
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STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

08/876,276

Applicant(s)

SHORT ET AL.

Examiner

David J. Steadman

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 22-34,36 and 38-46.

Claim(s) rejected: 19-21,35,37.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

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### ADVISORY ACTION

- [1] Claims 19-46 are pending in the application.
- [2] Claims 19-21, 35, and 37 stand finally rejected.
- [3] Claims 22-34, 36, and 38-46 are objected to as being dependent upon a rejected base claim.
- [4] The request for reconsideration in the after final amendment of Paper No. 36, filed May 30, 2003, is acknowledged. The amendment would appear to overcome the rejection previously set forth in the Office action of Paper No. 32. However, the amendment does not place the claims in condition for allowance because the amendment would require further consideration of the claims and a new search for the reasons stated below. See MPEP 714.13 regarding non-entry of after final amendments.
- [5] Applicant requests cancellation of claim 42 at page 2 of Paper No. 36, however the amendment states that claim 41 is cancelled at page 4 of Paper No. 36 and further states that claim 42 remains pending at page 5 of Paper No. 36. Thus, it is unclear as to applicant's intent as to the status of claims 41 and 42. In view of the amendment to claim 19 and the reiteration of claim 42 at page 5 of Paper No. 36, claim 42 is not further limiting and is an improper dependent claim. Also, due to the amendment to claim 19 to limit the claim to a method using clones containing DNA from more than organism, a new search would be required.
- [6] The rejection of claims 19-21, 35, and 37 under 35 U.S.C. 102(b) as being anticipated by Abeijon et al. (*Proc Natl Acad Sci USA* 93:5963-5968, 1993) is maintained. Applicant's arguments at pages 6 and 7 of Paper No. 36 have been fully considered. However, in view of the non-entry of the amendment, the rejection is maintained for the reasons of record. The amendment would appear to overcome the rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Thursday from 6:30 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.

  
 REBECCA E. PROUTY  
 PRIMARY EXAMINER  
 GROUP 1800  
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